



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

*AS*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,286	02/28/2001	Douglas B. Macrae	IS/112	1245

7590

09/23/2004

Alexander Shvarts  
Fish & Neave  
1251 Avenue of the Americas  
New York, NY 10020-1105

EXAMINER
----------

HUYNH, SON P

ART UNIT	PAPER NUMBER
----------	--------------

2611

DATE MAILED: 09/23/2004

*7*

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/720,286

Applicant(s)

MACRAE ET AL.

Examiner

Son P Huynh

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the generator" in lines 11,12,14. There is insufficient antecedent basis for this limitation in the claim. Examiner interprets this limitation as – the on screen electronic program guide generator.

Claim 1 recites the limitation "the program data" in lines 8,9. There is insufficient antecedent basis for this limitation in the claim. Examiner interprets this limitation as – the television program data.

Claim 1 recites the limitation "the on screen program guide" in line 14. There is insufficient antecedent basis for this limitation in the claim. Examiner interprets this limitation as – the on screen electronic program guide.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz (US 5,559,550), and in view of Alexander et al. (US 6,177,931).

Regarding claim 1, Mankovitz teaches a method for intermittently (periodically) downloading television program data to a plurality of user terminals equipped with a data receiver (tuner 1272, VBI decoder 1294 – figure 8A), a memory (program schedule memory 1282 – figure 8A) for storing television program data, an on screen electronic program guide generator (video processor 1296 – figure 8A), a microprocessor (1284 – figure 8A), and a television monitor (1280 – figure 8A) for displaying television programs and an electronic program guide (figure 9), the method comprising the steps of:

intermittently transmitting television program data to the user terminals (periodically transmitting program schedule to the television receiver – col. 9, lines 11-27);

storing the transmitted program data in the memory (storing program schedule into program schedule memory 1282 –col. 9, lines 11-23);

Art Unit: 2611

programming the microprocessor to transfer television program data from the memory to the generator in response to user commands (i.e., the viewer presses Guide/TV button 1312 on remote controller 1310 and the microprocessor 1284 recalls a portion of the program schedule database from memory 1282 and coupled it to video processor 1296 – col. 9, lines 45-56);

programming the microprocessor to control the generator to generate a video drive signal representative of an on screen television guide (in response to the command, the microprocessor recalls a portion of the program schedule database from memory 1282 and couples it to video processor 1296, where the program listings are formatted for display (col. 9, lines 45-67);

coupling the generator to the monitor to display the on screen program guide (coupling the video processor 1296 to the monitor 1280 to display the program listings – col. 9, lines 45-67 and figures 8A-9). Mankovitz further discloses using viewer input devices to control the system (col. 11, lines 3-30). The VCR can be turned off (col. 4, lines 25-67). Inherently, the data receiver is normally powered off. However, Mankovitz does not specifically disclose powering the data receivers on to intercept the transmitted data program.

Alexander teaches powering the data receiver on to intercept the transmitted data program (Instead of automatically recording the programs selected, the Watch function automatically turns the television on, if it is not already on, and automatically tunes to the television to the channel scheduled to deliver the designated program, if the television is not already tuner to that channel – col. 10, lines 2-10. As a result, the transmitted program data is intercepted).

Art Unit: 2611

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mankovitz to use the teaching as taught by Alexander in order to improve efficiency in data transmission and reduce power consumption.

Regarding claim 2, Mankovitz teaches the data receiver comprises a television tuner 1272 and VBI decoder 1294 and the transmitting step comprises embedding the program data in a television signal received by the tuner (figure 8A and col. 9, lines 18-27).

5. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz (US 5,559,550), and in view of Lett et al. (US 5,592,551).

Regarding claim 1, Mankovitz teaches a method for intermittently (periodically) downloading television program data to a plurality of user terminals equipped with a data receiver (tuner 1272, VBI decoder 1294 – figure 8A), a memory (program schedule memory 1282 – figure 8A) for storing television program data, an on screen electronic program guide generator (video processor 1296 – figure 8A), a microprocessor (1284 – figure 8A), and a television monitor (1280 – figure 8A) for displaying television programs and an electronic program guide (figure 9), the method comprising the steps of:

Art Unit: 2611

intermittently transmitting television program data to the user terminals

(periodically transmitting program schedule to the television receiver – col. 9, lines 11-27);

storing the transmitted program data in the memory (storing program schedule into program schedule memory 1282 –col. 9, lines 11-23);

programming the microprocessor to transfer television program data from the memory to the generator in response to user commands (i.e., the viewer presses Guide/TV button 1312 on remote controller 1310 and the microprocessor 1284 recalls a portion of the program schedule database from memory 1282 and coupled it to video processor 1296 – col. 9, lines 45-56);

programming the microprocessor to control the generator to generate a video drive signal representative of an on screen television guide (in response to the command, the microprocessor recalls a portion of the program schedule database from memory 1282 and couples it to video processor 1296, where the program listings are formatted for display (col. 9, lines 45-67);

coupling the generator to the monitor to display the on screen program guide (coupling the video processor 1296 to the monitor 1280 to display the program listings – col. 9, lines 45-67 and figures 8A-9). Mankovitz further discloses using viewer input devices to control the system (col. 11, lines 3-30). The VCR can be turned off (col. 4, lines 25-67). Inherently, the data receiver is normally powered off. However, Mankovitz does not specifically disclose powering the data receivers on to intercept the transmitted data program.

Art Unit: 2611

Lett teaches powering the data receiver on to intercept the transmitted data program (The subscriber terminal tunes to the EPG data channel whenever possible. For example, when the terminal is turned off, it enters an off mode and tunes a default channel, called an "off" channel – Col. 13, lines 4-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mankovitz to use the teaching as taught by Lett in order to improve efficiency in data transmission and reduce power consumption.

Regarding claim 2, Mankovitz teaches the data receiver comprises a television tuner 1272 and VBI decoder 1294 and the transmitting step comprises embedding the program data in a television signal received by the tuner (figure 8A and col. 9, lines 18-27).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mankovitz (US 6,341,195) teaches apparatus and methods for a television on screen guide.

Yuen et al. (US 6,239,794) teaches method and system for simultaneously displaying a television program and information about the program.




Art Unit: 2611

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P Huynh whose telephone number is 703-305-1889. The examiner can normally be reached on 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Son P. Huynh  
September 7, 2004



VIVEK SRIVASTAVA  
PRIMARY EXAMINER